

REMARKS

Claims 1-35 are pending in the application.

Claims 1-14, 19-21 and 25-32 have been rejected.

Claims 15-18, 22-24, and 33-35 have been objected to.

No amendments to the Claims have been made.

Reconsideration of the Claims is respectfully requested.

I. OBJECTION TO THE ABSTRACT

The Office Action objected to the Abstract of the present application due to the recitation of the phrase “is disclosed” in line 2. Applicant has amended the Abstract to remove the phrase “is disclosed,” as requested by the Examiner. Accordingly, Applicant respectfully requests the Examiner to withdraw the objection to the Abstract.

II. OBJECTION TO THE SPECIFICATION

The Office Action objected to the specification of the present application due to the recitation of an incomplete serial number on page 21. Applicant has amended page 21 of the specification to include the complete serial number, as requested by the Examiner. Accordingly, Applicant respectfully requests the Examiner to withdraw the objection to the specification.

III. OBJECTED CLAIMS

The Applicant thanks the Examiner for the indication that Claims 15-18, 22-24 and 33-35 would be allowable if rewritten in independent form to incorporate the elements of their respective base claims and any intervening claims. Because the Applicant believes that

the remaining claims in the present application are patentable, the Applicant has not rewritten Claims 15-18, 22-24 and 33-35 in independent form.

IV. REJECTION UNDER 35 U.S.C. § 102

Claims 1-14, 19-21 and 25-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by Jungerman (US Patent Application Publication 2002/0196055). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Regarding independent Claims 1, 6, 20 and 25, the Office Action asserts that Jungerman discloses “a first sampling circuit connected to sample a data signal...; a second sampling circuit connected to sample said data signal.” See, Office Action, page 2. However, Figure 3 of Jungerman and the passages cited by the Office Action do not appear to recite “a first sampling circuit” and “a second sampling circuit,” each for sampling “the data signal,” as recited in independent Claims 6, 20 and 25, and similarly recited in independent Claim 1. Instead, Jungerman appears to recite that one of the samplers (element 13) samples the data signal, while the other sampler (element 14) samples a clock reference signal. See, Jungerman, Figures 1 and 3 and paragraphs 23 and 27. Therefore, the Office Action has failed to demonstrate anticipation of each and every element of the Applicant’s independent Claims 1, 6, 20 and 25 (and their dependent claims) arranged as they are in the claims.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-14, 19-21 and 25-32.

V. REJECTION UNDER 35 U.S.C. § 103

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jungerman. This rejection is respectfully traversed.

Applicant respectfully submits that Jungerman is unavailable as prior art under 35 U.S.C. § 103 against the present application, because Jungerman and the present application are both assigned to Agilent Technologies, Inc., as the Examiner admits. See, Office Action, page 3. Under 35 U.S.C. § 103(c), subject matter which is prior art under 35 U.S.C. § 102(e) is disqualified as prior art under 35 U.S.C. § 103(a) if the subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” As a result, Jungerman is unavailable as “prior art” under 35 U.S.C. § 103 against the present application, and the Office Action has failed to establish a *prima facie* case of obviousness with respect to Claim 12.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claim 12.

VI. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at hrudnick@davismunck.com.

Respectfully submitted,

LOVELL H. CAMNITZ, ET AL.

Dated: 5/26/04



Holly L. Rudnick
Registration No. 43,065

Davis Munck PC
P.O. Drawer 800889
Dallas, Texas 75380
(Direct) (972) 628-3636
(Fax) (972) 628-3616
(Email) hrudnick@davismunck.com